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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,410	11/20/2003	Roger Rozot	016800-557	5557
21839	7590	11/17/2005	EXAMINER	
BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			SINGH, JAI P	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,410	Applicant(s) ROZOT ET AL.	
	Examiner Jai P. Singh	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 13-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the election of group III (claims 1-12) with traverse and election of species of pyrazolecarboxamide compound 1, as set forth in example 1, paragraph [0183] on page 10 of specification, filed dated September 22, 2005.

Examiner would like to mention that the compound 1 in example 1, paragraph [0183] on page 10 of specification is available in an image document. This is not available on the same page in specification provided in the original application. In the original application, the compound 1 is on p. 42 of the examples submitted.

Claims 1-52 are pending. Claims 1-12 are examined in this office action. Claims 13-52 are withdrawn from consideration as non-elected inventions. No claims allowed at this time.

Response to Arguments

1. Applicant's election with traverse of group III (claims 1-12) are drawn to method of use of at least one pyrazolecarboxamide compound formula (I), or a salt thereof, in a composition as an agent for inducing and/or stimulating

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the growth of keratin fibers, especially human keratin fibers, and/or for reducing their loss and/or increasing their density.

2. The traversal is on the ground that the search for claims in group I-V are closely related and therefore the examination of these simultaneously will give consistent search for all.

The arguments were fully considered but was not found to be persuasive. Examiner respectfully disagree that searching for group I-V simultaneously will give inconsistent and duplicate results and will not be a burden in examination. Examiner respectfully like to mention that when several species are present in the invention then searching for each compound with different substituents in the molecule will be enormous burden to search and evaluate prior art during the examination. In addition to this, the examination of the utility/applications of each compound will add additional burden for searching each compound in different compositions and method of use.

3. The applicant's argument based on the public's interest to obtain several patents of the applicant because of separate filing and reviewing those also not found to be persuasive.

Examiner respectfully disagree with this argument. Keeping public's interest in mind examiner would like to point out that public will benefit tremendously if the heart of the invention is disclosed in a manner which can easily be understood and put to use in future applications. It is important for public to know and evaluate the details of critical results (expected or

unexpected) obtained from different compounds in different compositions in different methods of use.

4. In addition to above consideration examiner further like to point out that the searches may be overlapping due to method of use of pyrazolecarboxamide compounds and its composition but there is no reason to believe that the searches may be co-extensive. It is also noted that the searches for the composition alone will not be sufficient to be a complete search for the method of using the composition. This means that examiner has to search and evaluate the art for other considerations such as enablement. Further, it is also noted that the search for methods of use may not alone be sufficient for the search for composition because the composition may be found to be useful in the prior art for entirely different application.

5. For the Office's rejoinder practice, please see the information set forth in the Office Action dated August 23, 2005. In this particular instance if the method of use claim is found allowable, the composition claim, within the same scope, will be rejoined as stated in the rejoinder statement set forth in the office action. The restriction requirement is still deemed proper and made final.

6. Claims 13-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 provides for the use of at least one pyrazolecarboxamide compound formula (I), or a salt thereof, in a composition as an agent for inducing and/or stimulating the growth of keratin fibers, especially human keratin fibers, and/or reducing their loss and/or increasing their density, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Applicant is requested to re-draft the claims according to US practice for further consideration and examination.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jai P. Singh whose telephone number is 571-

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272-8147. The examiner can normally be reached on M-F from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan (acting supervisor) can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPS
11/7/2005


SABIHA QAZI, PH.D
PRIMARY EXAMINER